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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TCL GoVideo

Serial No. 78395320

Harvey Kaye of Burns & Levinson, LLP for TCL GoVideo.

Shannon M. Twohig, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).¹

Before Seeherman, Grendel and Zervas, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

TCL GoVideo has applied to register YourDVD, in
standard character form, for goods that were ultimately
identified as "consumer electronic devices, namely: analog
and digital cellular phones; MP3 players and recorders; DVD
players and recording apparatus; portable digital audio
players and video disk players; combination video players

¹ This Examining Attorney took over responsibility for the
application at the time of preparing and filing the appeal brief.
She is not the Examining Attorney who examined the application.

and recorders; television sets; cameras; computer hardware; and circuitry which maintains previously made user settings.”² The Trademark Examining Attorney issued a final refusal of registration pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), with respect to certain of the goods, as discussed below, on the ground that applicant’s mark is merely descriptive of them. The Examining Attorney also made clear that the refusal did not pertain to the remaining goods in the application.

Applicant has appealed the refusal of registration. The appeal has been fully briefed; an oral hearing was not requested.

Before turning to the substantive issue on appeal, there are a number of points that we must address. At the time of the issuance of the final Office action, applicant’s identification of goods was for “consumer electronic devices, namely: analog and digital cellular phones; MP3 players and recorders; DVD players and recording apparatus; portable digital audio players and video disk players; combination video players and recorders; television sets; cameras; computer hardware; and

² Application Serial No. 78395320, based on Section 1(b) of the Trademark Act (intent-to-use). The application was originally filed by Opta Systems LLC. Office records show that ownership was subsequently transferred to TCL GoVideo.

features of DVD players and recorders." The Examining Attorney stated that the refusal of registration applied to only "DVD players and recording apparatus; portable digital audio players and video disk players; combination video players and recorders; television sets; and features of DVD players and recorders." The Examining Attorney also objected to the wording "features of DVD players and recorders" in the identification as being indefinite, and required that it be amended. In a request for reconsideration, applicant amended its identification to that shown in the first paragraph of this decision, specifically deleting "features of DVD players and recorders" and substituting therefor "circuitry which maintains previously made user settings." The Examining Attorney stated, in the February 1, 2006 Office action considering the request for reconsideration, that "applicant's identification of goods is acceptable." However, in her brief on appeal, although the Examining Attorney noted that applicant had stated in its brief that "the wording 'features of DVD players and recorders' has been eliminated and 'circuitry which maintains previously made user settings' has been added," she stated that "this brief will use the identification of goods contained in appellant's response dated May 9, 2005," which

identification included the term "features of DVD players and recorders." Examiner's brief, footnote 1. We do not know why the Examining Attorney has continued to treat this language as the identification of record, since the previous Examining Attorney had accepted the newer identification in the Office action dated February 1, 2006. This is particularly puzzling to us because, if the Examining Attorney believed that the phrase "features of DVD players and recorders" were still included in the identification, she did not address the acceptability of this phrase (the previous Examining Attorney having made final a requirement that applicant submit a definite identification for these items).³

In the final Office action, the Examining Attorney specified that the refusal of registration was made with respect only to "DVD players and recording apparatus; portable digital audio players and video disk players; combination video players and recorders; television sets; and features of DVD players and recorders." Because "features of DVD players and recorders" has now been deleted from the application, and because the Examining

³ We note that Office records continue to use the phrase "features of DVD players and recorders" in its listing of applicant's identification of goods. The identification will be corrected to reflect the identification of goods.

Attorney has not in any way indicated YourDVD is merely descriptive of "circuitry which maintains previously made user settings" (nor is there any evidence in support of such a position), we deem the refusal of registration to be limited to "DVD players and recording apparatus; portable digital audio players and video disk players; combination video players and recorders; and television sets."

With its request for reconsideration applicant submitted a disclaimer of exclusive rights to "DVD." The previous Examining Attorney ignored this disclaimer in his February 1, 2006 Office action, stating only that applicant's amended identification of goods was acceptable, but that the request for reconsideration was denied. In her appeal brief, the Examining Attorney noted the disclaimer:

Applicant has also volunteered to disclaim the term DVD apart from the mark as shown. While a disclaimer is not required in this instance, this is yet another indication of the descriptive nature of the term in relation to the applicant's goods.

Brief, p. 5. We note that the disclaimer has not been entered into the Office records (presumably because the prior Examining Attorney did not notice it in the request for reconsideration). While normally a disclaimer of a term is not required when the term is not a separate

element of a mark, as is the case with YourDVD, because an applicant may voluntarily disclaim any part of a mark, and because there was no objection by the Examining Attorney during examination when the disclaimer was offered, we have treated the application as including the disclaimer. Office records will be corrected to reflect this.

The next procedural point involves an objection raised by the Examining Attorney to "new evidence." The Examining Attorney "objects to the applicant's inclusion of any additional evidence with the appeal brief." Brief, p. 2. Applicant had submitted a number of third-party registrations with its appeal brief. With the exception of Registration No. 2204574 for MYCD, the Examining Attorney did not indicate the specific registrations that she believes are untimely filed. We note that with its response filed on May 9, 2005, applicant made of record several third-party registrations. Therefore, it would have been helpful to the Board if the Examining Attorney had specifically identified all the registrations that were submitted with applicant's brief that had not been submitted earlier, rather than simply mentioning Registration No. 2204574, and otherwise making a blanket objection to any registrations that were filed for the first time with applicant's brief. In our review of the

registrations submitted on May 9, 2005, compared with those submitted with the appeal brief, we find only one registration, No. 2204574 for MYCD, that was not previously submitted. In accordance with Trademark Rule 2.142(d), we have not considered this single registration because it is untimely, but all the others have been considered.

Finally, we note that the Examining Attorney has relied on an "unpublished" Board decision, In re 4YourParty.com LLC (SN 75932704, TTAB March 15, 2002). Decisions by the Board that are not designated as "citable as precedent" or "for publication in full" are not citable authority. See General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270 (TTAB 1992); and TBMP § 101.03 (2d ed. rev. 2004), and cases cited therein. Accordingly, we have not considered this decision in rendering our opinion.

This brings us to the substantive ground for refusal, namely, whether YourDVD is merely descriptive of "DVD players and recording apparatus; portable digital audio players and video disk players; combination video players and recorders; and television sets."

A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Trademark Act, if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or

services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). See also, In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978).

As shown by the identification itself, the term DVD per se clearly describes a characteristic of DVD players and recording apparatus; portable digital video disk players; and combination video players and recorders. These goods, as well as "television sets," are all items on which DVDs can be played and/or recorded. The NEXIS excerpts submitted by the Examining Attorney also refer to a "DVD/CD recorder," ("Network World," May 30, 2005); "a combo video/DVD recorder" ("PC Magazine," March 8, 2005); "a DVD player/recorder" ("M2 Presswire, April 25, 2005); and "DVD-Recorders, DVD-Audio Players" ("Business Wire," March 1, 2005).⁴

Applicant does not really dispute that DVD per se has a descriptive significance with respect to its goods, as shown by its disclaimer of this word. Rather, it is applicant's position that the additional element "YOUR" in its mark makes the mark suggestive. A suggestive mark is

⁴ The wire service reports have limited probative value because we cannot determine the extent of public exposure to them.

one for which imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services. In re Gyulay, supra. "When a prospective customer sees the product and this mark, it does not yet belong to the customer and this is not yet (insofar as this customer is concerned) Your DVD." Brief, p. 9.

In support of its position, applicant has made of record a number of third-party registrations for "MY" marks. They include MYDVD for, inter alia, "computer software for creating, editing, authoring, formatting or producing audio and video production files," and "recordable medium, namely, magnetic disks, optical disks, compact disks, video compact disks and magnetic tapes having audio and video production files featuring movies recorded thereon";⁵ MY DISC, with DISC disclaimed, for "premastering software for preparing print images and formatting data for storage on media such as compact disks";⁶ MY RECORDS, with RECORDS disclaimed, for "musical sound recordings, musical video recordings, and sound recordings featuring the spoken word and comedic performances";⁷ MY BUSINESS CARDS for "computer program

⁵ Registration No. 2623300.

⁶ Registration No. 2363321.

⁷ Registration No. 2228288.

with graphics capability for creating and designing business cards";⁸ and "MY BEEPER," with BEEPER disclaimed, for radio pagers and paging services."⁹ Applicant contends that there is no reason to distinguish between the pronoun "my" and the pronoun "your" regarding whether or not a mark is descriptive. Thus, because the combination of MY with a term that describes a characteristic of the goods has resulted, in many instances, in a registrable term, applicant asserts that the same result should obtain when a mark contains the pronoun YOUR.

In response to this argument, the Examining Attorney simply states that applicant's mark is different because it contains the word YOUR and not the word MY, and therefore the third-party registrations for "MY" marks are of limited relevance. The Examining Attorney also points to a decision by the Board in which YOUR HEALTH INSURANCE MANAGER for "software programs for personal record keeping and processing of medical records, health insurance and claims" was found to be merely descriptive. In re Time Solutions Inc., 33 USPQ2d 1156 (TTAB 1994).

We see no reason why, in general, a distinction should be made between the words MY and YOUR in terms of

⁸ Registration No. 2334056.

⁹ Registration No. 1842791.

whether a mark is merely descriptive. As for the Times Solution decision, as the Examining Attorney has noted, that opinion discussed primarily whether the term MANAGER was descriptive. Virtually nothing was said about the presence of the word YOUR in that mark, except to note that the specimens of record included the language "new PC software to manage your medical records and health insurance." We think, in that situation, the word YOUR related to an individual's medical records and insurance, such that it did not modify MANAGER. As a result, we do not extrapolate from that decision that whenever the word YOUR is combined with a term that is descriptive of a characteristic of the goods or services, the mark as a whole is merely descriptive.

We recognize that the word YOUR adds very little to the word DVD in the mark YourDVD. However, as applicant says, when a potential consumer sees the mark on the goods in a store or in an advertisement, the goods are not "his," and so, at that point, the goods are not yet "Your DVD." Further, DVD is a recognized word for a digital video disk. While the term also describes a characteristic of a DVD player, when DVD is used as part of the mark YourDVD the immediate reaction is that of the disk itself, and consumers must go through the mental step

of recognizing that, as applied, for example, to television sets, YourDVD does not refer to the video disk but the fact that the video disk can be played on the television. This mental "hiccup" is sufficient to put YourDVD into the category of a suggestive mark.

It has often been said that there is a but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. In *re* Recovery, Inc., 196 USPQ 830 (TTAB 1977). Moreover, when reasonable people may differ, it is well established that doubt must be resolved in applicant's behalf. See *In re* Gracious Lady Services, Inc., 175 USPQ 380 (TTAB 1972). Because we have such doubt in this case, we resolve it in favor of applicant, and reverse the refusal of registration.

Decision: The refusal of registration is reversed. Office records will be corrected to include the disclaimer of DVD and to show the operative identification of goods as "consumer electronic devices, namely: analog and digital cellular phones; MP3 players and recorders; DVD players and recording apparatus; portable digital audio players and video disk players; combination video players

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and recorders; television sets; cameras; computer hardware; and circuitry which maintains previously made user settings."